

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: RUBENSTEIN=10A

In re Application of:)	Conf. No.: 1894
)	
Menachem RUBINSTEIN et ak)	Art Unit: 1654
)	
Appln. No.: 10/552,591)	Examiner: Andrew D. KOSAR
)	
I.A. Filed: 04/07/2004)	Washington, D.C.
371 (c): 08/02/2006)	
)	
For: LONG-ACTING DERIVATIVES)	April 3, 2009
OF PYY AGONISTS)	

REPLY TO RESTRICTION AND ELECTION REQUIREMENTS

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building, 401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants are in receipt of the Office Action mailed March 6, 2009, entirely in the nature of requirements for restriction and election of species on the basis of purported lack of unity of invention.

As applicants must make an election with respect to the restriction requirement even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group I, presently claims 1-8, with traverse and without prejudice.

The examiner has taken the position that there is a lack of unity of invention on the basis of (i) US 6,297,214,

which teaches Fmoc protected GLP-2; and (ii) Tang-Christensen et al. (Nat. Med., 2000, 6(7), 802-807), which teaches that GLP-2 inhibits feeding behavior, i.e., it is a "molecule that has PYY or PYY₃₋₃₆-like biological activity such as reducing food intake in mammals, and acts by a mechanism similar to that of PYY and PYY₃₋₃₆". Applicants respectfully submit that the citations do not establish lack of unity of invention.

The traversal is based on the fact that although derivatives of the formula (X)_n-Y such as Fmoc-GLP-2 were disclosed in the prior art, those derivatives have nothing to do with the common technical feature linking Inventions I and II. In particular, US 6,297,214 discloses GLP-2 synthesis wherein Fmoc is used as a blocking group, whereas the common technical feature of the present application in both Groups I and II is the use of either FMS or Fmoc radicals, removable under mild basic conditions, for the preparation of conjugates of PYY agonists having a prolonged half-life in the circulation.

Thus, unity of invention exists according to the standards of PCT Rules 13.1 and 13.2; and the requirement should be withdrawn, and all the claims should be examined on the merits.

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Applicants have also been required to elect a species of the PYY agonist. Accordingly, applicants respectfully and provisionally elect (FMS)₂-PYY₃₋₃₆, with traverse and without prejudice. The claims of elected Group I which read on the elected species are claims 1, 3 and 5-8, as well as all of claims 17-23 of Group II.

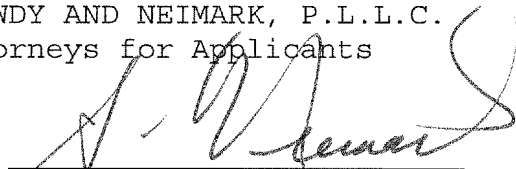
The requirement is traversed on the basis that the generic claims inherently cover all species and thus set forth a single general inventive concept providing the same or corresponding technical features as required by PCT Rules 13.1 and 13.2.

Accordingly, the requirement should be withdrawn and such is respectfully requested.

Respectfully submitted,

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